

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ALAN SUARES;
SUSAN NETTESHEIM;
MICHAEL INDURSKY; and
PETER BERTOLINI

Appeal No. 2001-1489
Application No. 09/177,695

ON BRIEF

Before LORIN, ADAMS and GRIMES, Administrative Patent Judges.

LORIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-11, all the claims pending in the application.¹

¹ Pursuant to 35 U.S.C. § 6(b), we review the adverse decision of the examiner. In doing so, we have considered the record, including:

- Final Rejection (paper no. 7);
- Brief (paper no. 9); and,
- Examiner's Answer (paper no. 10).

Claims 1 and 11 are illustrative of the claims on appeal and read as follows:

1. A method for cosmetically improving human skin through a treatment regime comprising:

- providing a first composition containing at least one first active within a first pharmaceutically acceptable carrier, the first composition functioning to impart a first benefit to the skin;

- providing a second composition containing at least one second active within a second pharmaceutically acceptable carrier, the second composition functioning to impart a second benefit to the skin, the first and second actives and benefits being different from one another;

- storing the first composition in a first container;

- storing the second composition in a second container, the first and second containers being joined together;

- instructing consumers by placing on the containers or packaging associated therewith instructions on use of the first and second compositions in a sequential manner to achieve the first and second benefits in a treatment regime, the first and second compositions being complementary products;

- applying the first composition to the skin to achieve the first benefit; and

- applying the second composition to the skin after application of the first composition to achieve the second benefit.

11. A skin treatment regime product comprising:

- a first composition containing at least one first active within a first pharmaceutically acceptable carrier, the first composition functioning to impart a first benefit to the skin;

- a second composition containing at least one second active within a second pharmaceutically acceptable carrier, the second composition functioning to impart a second benefit to the skin;

- a first container for storing the first composition;

- a second container for storing the second composition, the first and second containers being joined together; and

- instructions for consumers placed on the containers or packaging associated therewith on use of the first and second compositions in a sequential manner to achieve the first and second benefits in a treatment regime, the first and second compositions being complementary products.

The references relied upon by the examiner are:

Van Scott et al. [Van Scott]	U.S. 4,234,599	November 18, 1980
Dutch Patent [Dutch Patent]	NL 9301506	April 3, 1995
German Patent [German Patent]	DE 2904478 A1	August 21, 1980
"Jacqueline Cochran Perk-Up Set," [Jacqueline Cochran Advertisement] New York Times, April 11, 1948, Sec. 1. p. 64.		

Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Scott, Dutch Patent, German Patent and the Jacqueline Cochran Advertisement.

DISCUSSION

The issue for our review is whether the claims are properly rejectable under 35 U.S.C. § 103(a) as being obvious over Van Scott, Dutch Patent, German Patent and the Jacqueline Cochran Advertisement.

In reviewing, on appeal, a PTO Board's findings and conclusions, the Federal Circuit has stated that "[f]or judicial review to be meaningfully achieved within these strictures², the agency tribunal must present a full and reasoned explanation of its decision. The agency tribunal must set forth its findings and the grounds thereof, as supported by the agency record, and explain its application of the law to the found facts." In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1432-3 (Fed. Cir. 2002). "The

² "5 U.S.C. §706(2) The reviewing court shall—

(2) hold unlawful and set aside agency actions, findings, and conclusions found to be—

(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;

* * * *

(E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute;"

agency tribunal must make findings of relevant facts, and present its reasoning in sufficient detail that the court may conduct meaningful review of the agency action.” Ibid. at 277 F.3d 1346, 61 USPQ2d 1435. “Remand for these purposes is required.” Ibid. at 277 F.3d 1346, 61 USPQ2d 1436.”

Since the Board also serves as a board of review, not a de novo examination tribunal (35 U.S.C. § 6(b)), in order for the Board to make a meaningful review of the rejection on appeal, examiner likewise must present a full and reasoned explanation in support of the final rejection. As we explain below, that has not been done here. Accordingly, we remand the application to give the examiner a new opportunity to more thoroughly present the grounds of rejection. If the opportunity is taken, examiner should consider amending the grounds of rejection so that, as we explain below, a stronger question of patentability might be raised. Accordingly, we will vacate the present rejection and remand the application to give the examiner an opportunity to consider applying a new ground of rejection.

Claims 1-10 and 11 are directed to a method for cosmetically improving human skin through a treatment regime and a skin treatment regime product, respectively. Claims 1-11 are rejected as obvious under 35 U.S.C. § 103 over Van Scott, Dutch Patent, German Patent and the Jacqueline Cochran Advertisement. Accordingly, examiner has the burden of establishing a prima facie case of obviousness for the claimed method of cosmetically improving human skin through a treatment regime and

In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433-4 (Fed. Cir. 2002).

the skin treatment regime over Van Scott, Dutch Patent, German Patent and the Jacqueline Cochran Advertisement. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

To meet the burden of establishing a prima facie case of obviousness, we are directed to Paper No. 5 for the grounds of rejection (see Examiner's Answer, top of p. 4). We reproduce in its entirety the factual statements in support of examiner's prima facie case of obviousness (taken from p. 3 of Paper No. 5):

The instant application is claiming a method for cosmetically improving the skin using two separate containers where two different compositions are stored, where the containers are stacked above one another and the colors of the containers are different and [sic] applicants are also claiming skin regime product using the above containers.

DE translated text teaches set of containers for storing cosmetics. See page 3 of the text, see page 5 see Fig.5.

The Dutch patent also teaches containers for holding toiletry products such as creams and perfumes. See page 2 last paragraph, page 3, lines 1-10, see page 4 and see the claims. The difference between the references and the instant application is that the references do not specifically teach the method for improving skin. The article in the N.Y. Times [Jacqueline Cochran Advertisement] teaches beauty kit with stack able [sic: stackable] containers which holds different components [sic: .] Thus the cited art teaches the concept of stack able [sic: stackable] containers for holding the cosmetics. With respect to claim 9 the Vanscott [sic: Van Scott] patent teaches treating skin with the active ingredients claimed.

On this basis, examiner (p. 3 of Paper No. 5) concludes:

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to use stack able [sic: stackable] containers for holding two different compositions taught by the translated patents and the article and use to treat the skin by using the active ingredients of Vanscott [sic: Van Scott] Patent expecting aesthetic advantage. This is a prima facie case of obviousness.

Examiner has failed to address all the claimed limitations. Here, not all the differences between the claims and prior art have been identified and addressed. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The following claimed limitations have not been adequately addressed:

1) the step of instructing consumers placing instructions on the containers as described in claims 1, 10 and 11;

2) the requirement that the first and second compositions be “complementary” products as described in claims 1 and 11;

3) the requirement that the first and second containers be fitted with a coupling means, that “the means for coupling is a threaded screw”, and “releasably locked” as described in claims 2, 3 and 4, respectively;

4) the color codings of claims 5 and 6;

5) the pump mechanism as described in claim 7;

6) any one of the benefits and active ingredients listed in claims 8 and 9, respectively;

7) the use of the two compositions in a “sequential manner” as set forth in claim 10;

8) and similar limitations set forth for the treatment regime product of claim 11.

Since examiner has not addressed each and every limitation in the claims, we are not presented the necessary factual analysis to make a meaningful review of examiner’s position that the claims are prima facie obvious over the cited art combination.

Examiner's conclusion of obviousness over the cited prior art combination must be supported by substantial evidence as supported by the record. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1432 (Fed. Cir. 2002). The legal conclusion that there exists a prima facie case of obviousness is based on factual inquiries. See Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). "The factual inquiry whether to combine references must be thorough and searching." McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001).

The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.

In re Lee, 277 F.3d 1338, 1342-1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

We find that the factual support for examiner's position has not been thoroughly presented and therefore the conclusion of obviousness is not supported by substantial evidence. Until we know examiner's reasoning leading up to the conclusion that the claimed process for cosmetically improving human skin and skin treatment regime product would have been obvious over the cited art combination, the panel cannot make a meaningful review of the rejection of the claims. As a result, we vacate the rejections of record, and remand the application for further clarification of the grounds of rejection.

While we reach no decision on the merits of this appeal, we offer the following comments in an effort to advance prosecution and assist the examiner in clarifying the grounds of rejection.

Claim 1 is directed to a process for cosmetically improving human skin through a treatment regime. At present, this claim has been rejected as obvious under 35 U.S.C. § 103 over Van Scott, Dutch Patent, German Patent and the Jacqueline Cochran Advertisement. As we have stated, this rejection is not supported by substantial evidence because not all the limitations of the claim have been addressed.

Notably, the following step has not been addressed:

instructing consumers by placing on the containers or packaging associated therewith instructions on use of the first and second compositions in a sequential manner to achieve the first and second benefits in a treatment regime,

Examiner does mention it in the "Response to Argument" section of the Examiner's Answer (p. 4), wherein examiner concludes that:

The instructions on the containers (printed matter) does not carry any patentable weight, as it is within the ken of the skilled chemist to provide the instruction so that the consumers can use it.

Suffice it to say that if, during subsequent prosecution, examiner should repeat this statement, examiner would be improperly dismissing this step as not being a limitation in the claim. In point of fact, the printed instructions may carry patentable weight.

Differences between an invention and the prior art against it cannot be ignored merely because those differences reside in the content of the printed matter. [The examiner] cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim unpatentable. The claim must be read as a whole.

In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 403 (Fed. Cir. 1983).

Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.

Id., at 703 F.2d 1386, 217 USPQ 404. In any subsequent proceeding wherein examiner rejects this claim, the instruction step must be addressed and, in doing so, this critical question answered. Examiner should be mindful, however, that

Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight.

In re Lowry, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1033 (Fed. Cir. 1994). In our view, claim 1 does not set forth any functional relationship between the instructions and the container. Accordingly, on that basis, we would agree that the printed matter does not distinguish over the prior art combination.

Also, claim 1 requires that “the first and second compositions [be] complementary products.” While, as we have stated, the grounds of rejection does not address this, it is discussed in examiner’s response to appellants’ argument (Examiner’s Answer, p. 5):

In response to the above argument, it is the position of the examiner that all the references teaches [sic: teach] the concept of using the containers for different cosmetic products (emphasis added). Therefore one of ordinary skill in the art would be motivated to use the two different products that may be complimentary [sic: complementary]. This is the case with the instant application.

However, if repeated during subsequent prosecution, these statements do not satisfactorily explain how one of ordinary skill would be led to modify the prior art to provide for “complementary” first and second compositions. Albeit examiner concludes that “one of ordinary skill in the art would be motivated to use the two different products that may be “complementary,” there is no straightforward connection between “different” products and “complementary” products. Rather, the scope of the term “complementary” should first be established before determining whether the claimed invention encompasses the “different” products disclosed in the cited prior art. In that regard, “the claims are given their broadest reasonable interpretation in light of the specification.” In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). The specification mentions “complementary” only in lines 1-6 of page 2 of the specification but only in terms of the type of product a person would want to use. The term is never defined. Accordingly, the term must be given its plain meaning. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). The plain meaning of “complementary”, in the context of the claims, is that one composition would act to make up what is lacking in another composition, so as to make a complete cosmetic regime. In light of that interpretation, we would agree with examiner that the prior art shows using “complementary” products in a skin treatment regime. The Jacqueline Cochran Advertisement, for example, shows a cleanser cream, then a foundation cream and then a night cream. It is fairly evident that the cleansing cream must be used

first to be followed by the other creams. It follows that the cleansing cream “complements” the foundation and night creams by providing the cleansing function the other creams rely upon but do not possess. Accordingly, on that basis, we would agree that the claimed complementary products do not distinguish over the prior art combination.

If the two limitations of claim 1 not addressed in the present grounds of rejection are subsequently addressed in accordance with the discussion above, there would be substantial evidence to establish a prima facie case of obviousness under 35 U.S.C. § 103 for claim 1 over the cited art combination. In particular, a rejection of claim 1 under 35 U.S.C. § 103 over the Jacqueline Cochran Advertisement alone would appear to present a substantial question of patentability. We are satisfied that the illustration in the Jacqueline Cochran Advertisement of jars of cleansing cream, foundation cream, night cream, rouge, and powder, “fitted together” in that order, is otherwise a disclosure of at least two compositions with different active ingredients stored independently of each other in separate containers joined together for use in a skin treatment regime whereby each composition is applied one after the other for their respective benefits.

Claim 2 further limits the claim 1 method by requiring the containers to be “fitted with a means for coupling same to one another.” The Jacqueline Cochran

Advertisement shows the jars “fit together.” Presumably, this is accomplished by a “coupling means”.

Regarding claims 3 and 4, which add to the method of claim 2 the requirement that the first and second containers be joined such that “the means for coupling is a threaded screw” or are that the containers be stacked and “releasably locked” together, respectively, we do not see where this is disclosed in the cited prior art. The “five little jars” shown in the Jacqueline Cochran Advertisement appear to be coupled in a lockable relationship to each other. However, given the legibility of the copy of the reference provided to us, it is difficult to tell whether they are coupled by threaded screws. The advertisement’s use of the word “jar” would suggest that that might be the case. To be sure, if examiner applies the Jacqueline Cochran Advertisement against this claim, we suggest obtaining the original advertisement to be certain. As to the limitation that the containers be “releasably locked,” the specification nowhere defines these terms and, consequently, they should be given the plain meaning of the words, i.e., that the containers are capable of being engaged in an open and closed arrangement. Such an arrangement would appear to be exhibited by the “five little jars fit together” in the Jacqueline Cochran Advertisement.

Regarding the color indications set forth in claims 5 and 6, although examiner mentions the color limitation in the grounds of rejection, it does not appear to be fully addressed. In the Response to the Argument, examiner states that

... it is the position of the examiner that one of ordinary skill in the art would use two different colors so that it is easy and convenient for the consumers. Selection of two different colors is within the gambit [sic: ambit?] of the skilled chemist.

If this is repeated during subsequent prosecution, it should be supported with factual evidence.

[The] factual question of motivation is material to patentability, and [can] not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

As to the pump mechanism as described in claim 7, we note that examiner (Examiner's Answer, p. 6) has argued that this is shown by the Dutch Patent. While this may be the case, the question is not whether any individual element of the claimed invention is taught in the prior art. The question is whether the prior art would suggest the claimed invention as a whole. Upon subsequent prosecution, in making the necessary analysis, examiner should be mindful that the mere fact that the prior art could be modified to obtain the claimed process does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "To establish a prima facie case of obviousness based on a combination of references, there must be a teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant." In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637

(Fed. Cir. 1998). Accordingly, if examiner maintains the rejection of this claim during subsequent prosecution, examiner should explain how the prior art would suggest to one of ordinary skill to employ independent pumps in a process for cosmetically improving human skin as described by claim 7.

Claim 8 is directed to the various benefits obtainable from the first and second compositions of the treatment regime of claim 1. Among the benefits are cleansing and moisturizing. Given the disclosure of “cleansing cream” and “night cream”, the Jacqueline Cochran Advertisement would appear to suggest these benefits as well.

Claim 9 is directed to various substances and materials as candidates for the active materials of the first and second compositions of the treatment regime of claim 1. In any subsequent prosecution, examiner may want to establish, through applied prior art, that any number of these materials, e.g., surfactants, are known additives with known functions in skin treatment products such as creams, and one would be lead to include any one of these materials in the creams of, for example, the Jacqueline Cochran Advertisement, to obtain the benefit commonly associated with that material.

Claim 10 further limits the instruction step of claim 1 to instructions on use of the two compositions in a “sequential manner.” Our comments made earlier on the subject of printed matter are equally applicable here.

Claim 11 is directed to the skin treatment regime product that is used in the process of claim 1. Examiner should review our comments above in treating this claim in any subsequent prosecution of this application.

For the foregoing reasons, the position put forward by the examiner in support of the rejection of claims 1-11 over Van Scott, Dutch Patent, German Patent and the Jacqueline Cochran Advertisement is not amenable to a meaningful review. Accordingly, we vacate the rejection of record and remand the application so that the examiner may provide a more reasoned review of the record. Upon return of the application, the examiner should step back and reassess the grounds of rejection for the pending claims in view of the comments made herein. Examiner should reformulate the rejection and provide a clear and consistent analysis that explains how the prior art disclosures, would lead one of ordinary skill to modify the teachings therein to thereby derive the claimed process and product. In doing so, examiner should address every limitation in the claims and establish differences between the claims and the prior art and, where differences exist, explain why the prior art provides substantial evidence supporting a prima facie case of obviousness of the claimed process and product. In that regard, we recommend that examiner review MPEP § 706.02(j) for a model of how to explain a rejection under 35 U.S.C. § 103.

For the foregoing reasons, we vacate the rejection under § 103 and remand to give the examiner an opportunity to consider the issues discussed herein and take

appropriate action not inconsistent with the views expressed herein. We emphasize that we vacate examiner's rejections. This means that the instant rejection no longer exists and the issues set forth herein cannot be satisfied by a Supplemental Examiner's Answer. See Ex parte Zambrano, 58 USPQ2d 1312, 1313 (Bd. Pat. App. & Int. 2000).

VACATED AND REMANDED

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